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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/672,154 | 09/27/2000 | Masahiko Sato | 450100-02733 | 6619 |
| 20999 | 7590 | 08/25/2004 | | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER RAMAN, USHA | |
| | | | ART UNIT 2616 | PAPER NUMBER 7 |
| DATE MAILED: 08/25/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,154

Applicant(s)

SATO, MASAHIKO

Examiner

Usha Raman

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Response to Arguments

1. Applicant's arguments filed May 25th 2004 have been fully considered but they are not persuasive. Examiner duly notes applicants argument in page 9 stating that Dunn's system is equivalent to prior art systems because it sends *all* program information to the user instead of just the program IDs, however claim 1 specifically recites that, "*the user server is configured to receive and store the broadcast program information...user server operating to receive from the data server a select number of program retrieval identification codes.*" Despite applicant's attempt to clarify the operation between user server and the data server of the program retrieval system through amended claims and arguments, claim 1 still fails to point out the limitation that the user server receives *only* program retrieval identification codes in response to a search query.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 8-9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn (5,945,987).

In regards to claims 1 and 9, Dunn discloses a broadcast program retrieval system for retrieving a desired broadcast program (VOD) among a

plurality of broadcast programs. The system comprises a head end with a program information database that maintains program data records containing program IDs (program retrieval identification information) and other program related information, the database having search capability for searching the program information database. Note column 2, lines 54-62, and column 3, lines 19-33. The system also comprises a user server configured to receive and store the broadcast program information (program information sent by head end), the user server operating to send to the data server a search query comprising a content keyword for searching the broadcast program information for a desired broadcast program (note column 7, lines 20-25) and the user server operating to receive from the data server a select number of program ID related to at least one content keyword as a result of the searching by the data server (note column 8, lines 48-54, column 9, lines 26-40, and column 12, lines 30-40). Also note column 5, lines 59-64, column 6, lines 1-5, and lines 22-30. Dunn discloses that the program information records containing program ID sent from the head end are stored locally in the RAM of the user server and that additional information related to the program can be displayed. Therefore, the program ID enables the additional information related to the program to be retrieved from the program records locally and allows the user server to select the desired program from among a plurality of program information. Note column 7 lines 57-63, column 9, lines 35-40, and column 11, lines 47-50.

In regards to claim 2, the user server is connected to the head end through a communication link (cable network). Note figure 1.

In regards to claim 3, Dunn discloses that the search criteria can include element of the content forming the broadcast program, such as category, title, actor, etc. Note column 7, lines 20-25.

In regards to claim 4, Dunn discloses that each of the broadcast programs are uniquely identified by a program ID in the program data record. Therefore the broadcast program inherently has a program ID appended in an "event information region" in order to properly identify the program specified by a program ID. Note column 2, lines 56-59.

In regards to claim 6, Dunn discloses that the program information sent by the head end to the user server is used by a plurality of applications running on the set top box including an electronic program guide. Note column 4, lines 1-5.

In regards to claims 8 and 11, Dunn discloses that the data server comprises a "keyword" database where a plurality of keywords related to a program (such as categories, title, actor, etc.) are used to match at least one content keyword (search criteria) received from the user server. Note column 8, lines 55-67 and column 9, lines 1-7.

In regards to claim 14, Dunn discloses that among one of the searching functions, a viewer can select items from the "viewer list" that contain the programs that have been added by the user and therefore reflects the user's preference. Note column 10, lines 32-36 and column 9, lines 55-63.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 10, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (US Pat. 5,945,987).

In regards to claim 7 and 10, Dunn does not disclose that the program ID is unique for each of the plurality of broadcasts of the same program. Official notice is taken that a program data records in an EPG uniquely identified by the channel and time (as seen on an EPG grid). Therefore, each of the program data record is uniquely identifiable, i.e. a program airing at two different times containing different program IDs corresponding to two different program records of the same programs with different schedule times. It would have been obvious to one of ordinary skill in the art at the time of the invention to identify each of the program records for the same program uniquely thereby allowing the program IDs same program being aired at different times to be easily identified and differentiated.

In regards to claim 12, Dunn does not disclose that the program retrieval system updates the keyword database with any changes made to other information related to the broadcast programs. Official notice is taken that it is well known for head ends often receive "up to date" cyclically from a plurality of

satellite feeds (downlink feed) and/or other master head end sources. Therefore changes in the information related to a program are reflected in "up to date" program information records received from such master head ends. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the system of Dunn with a master head end for cyclically providing information reflecting any changes in the broadcast program information, in order to ensure that the local head ends have the most up to date broadcast program information.

In regards to claim 13, modified system of Dunn discloses that the program information record includes other information related to the broadcast programs such as cast members (list of performers) appearing on each of the broadcast programs in addition to program ID. Note column 5, lines 56-67.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-308-5359.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UR
08-23-04



HAITRAN
PATENT EXAMINER